

Remarks

Currently pending in the application are claims 13-25.

Information Disclosure Statement

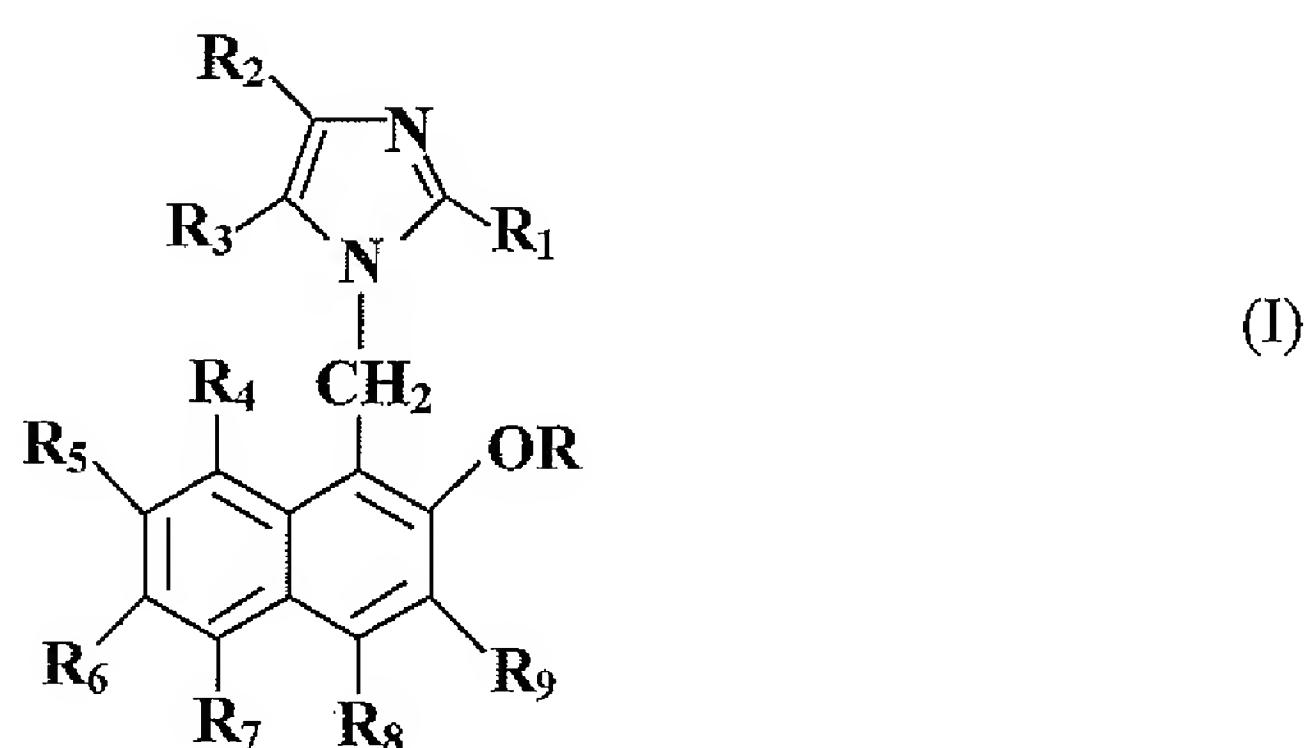
It is respectfully requested that the documents listed on the attached Form PTO/SB/08 be considered by the Patent and Trademark Office in the above-entitled application and made of record therein.

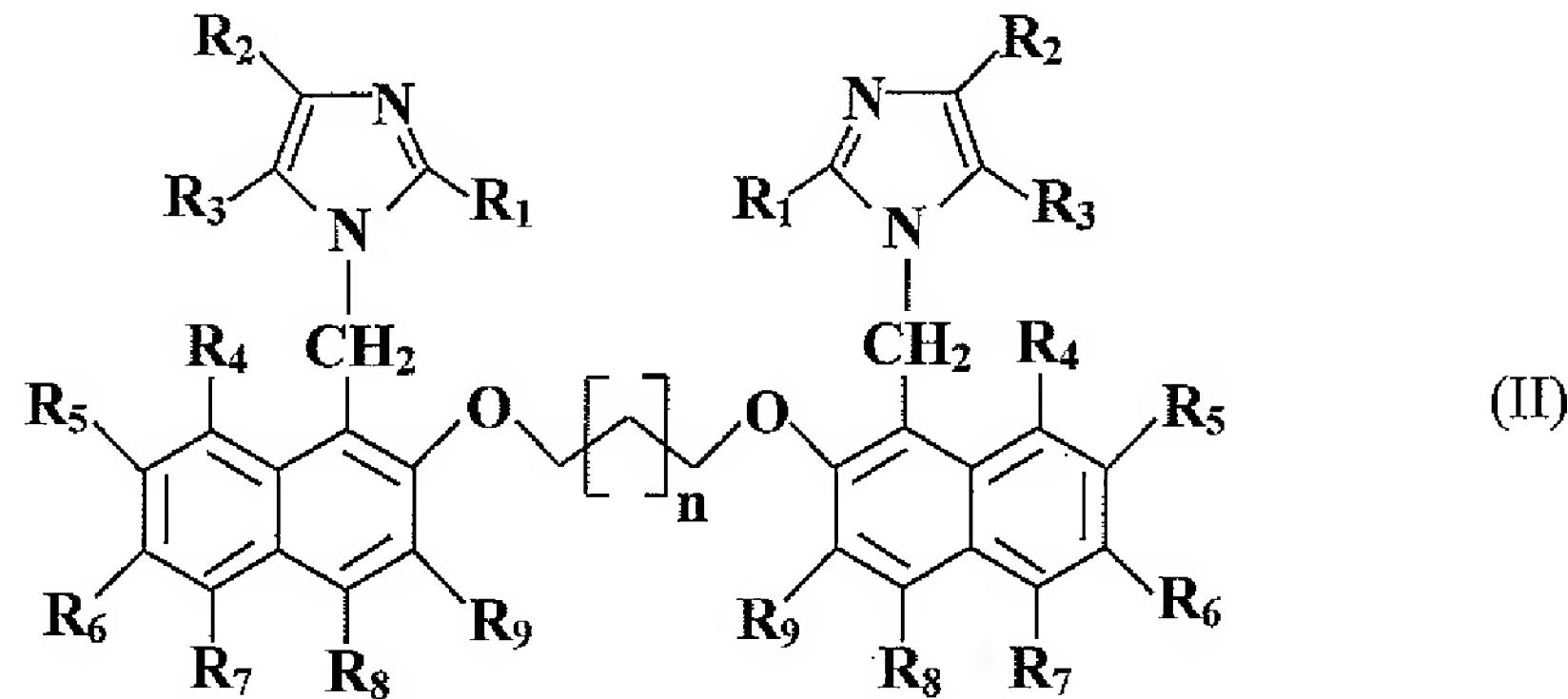
The Examiner is requested to indicate consideration of this art on the attached Form PTO-1449 by initialing next to the items submitted by Applicant.

35 U.S.C. § 102(b)

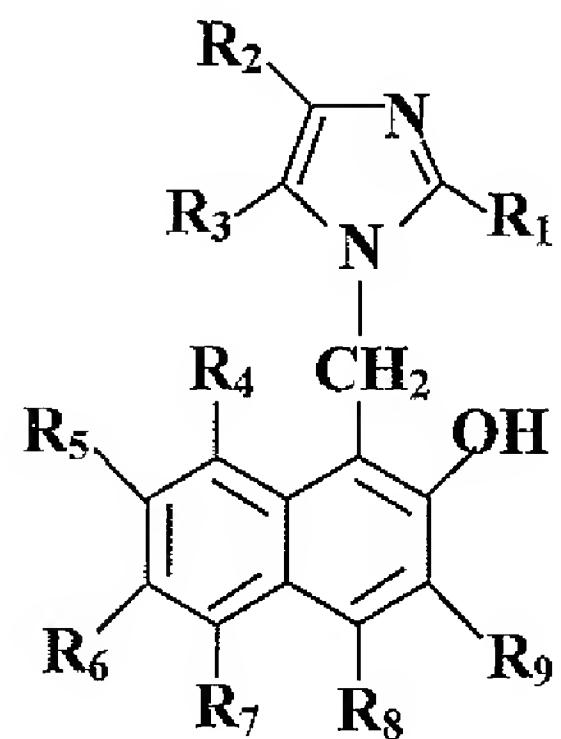
The Examiner rejected claims 13-17 and 23 under 35 U.S.C. § 102(b) as being anticipated by Blykahman (U.S. Pat. No. 5,591,811). Applicant respectfully traverses this rejection for the following reasons.

Claims 13-17 and 23 are directed to a compound of general formula (I) or (II) and a method for making a curable composition by adding to an epoxy resin, a curing agent and a compound of formula (I) or (II). The compounds of formula (I) or (II) are naphthalene derivatives in which the hydroxyl group at the β or 2-naphthol position is alkylated and are represented by:





In comparison, Blykahman discloses 1-imidazolylmethyl-2-naphthols having the general formula:



Blykahman neither discloses nor suggests a naphthalene derivative in which the hydroxyl group at the β or 2-naphthol position is alkylated. Since each and every element set forth in claims 13-17 and 23 are not found, either expressly or inherently, in Blykahman, claims 13-17 and 23 are not anticipated by Blykahman. Accordingly, Applicant respectfully requests the rejection based on 35 U.S.C. § 102(b) be withdrawn.

35 U.S.C. § 103(a)

The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Blykahman in view of Okita et al. (U.S. Pat. No. 5,298,649). The Examiner also rejected claims 19-22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Blykahman in view of Klein et al. (U.S. Pat. No. 6,245,835). The Examiner further rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Blykahman in view of Forgo et al. (U.S. Pat. No. 4,666,954). Applicant respectfully traverses these rejections for the following reasons.

For the reasons stated above, Blykahman neither discloses nor suggests a naphthalene derivative in which the hydroxyl group at the β or 2-naphthol position is alkylated as presently claimed. Thus, the similarity is predicated on the substitution of hydrogen by an alkyl substituent in one specific place in the 1-imidazolylmethyl-2-naphthols compounds referred to in Blykahman. There are, however, many other places in these compounds to make such a substitution. There is no teaching or suggestion in Blykahman nor has the Examiner demonstrated that it would have been obvious to one of ordinary skill in the art to make the substitution of hydrogen at that *particular* position at which Applicant has placed the alkyl substituents so as to enhance the interlaminar shear strengths of cured compositions. Where “there is no teaching that substitution in certain other spots is beneficial, one who teaches otherwise has made an unobvious contribution to the art.” *In re Wagner*, 371 F.2d 877 at 885 (C.C.P.A. 1967).

Adding the teachings of Okita et al., Klein et al. and Forgo et al. does not bring one skilled in the art closer to Applicant’s claimed invention. While Okita et al. does teach naphthalene derivates, the naphthalene derivatives taught in Okita et al. are

completely different compounds than the compounds of formula (I) and (II) of the present invention. In particular, Okita et al. does not teach or suggest naphthalene derivatives having a 1-imidazolylmethyl substituent. Moreover, the ether moiety in the compounds of Okita et al. is attached at the α or 1-position while the ether moiety in the compounds of formula (I) and (II) is attached at the β or 2-position. Finally, Klein et al. and Forgo et al. neither teach nor suggest compounds of the formula (I) or (II), or their use in a curable composition or prepeg as presently claimed. Applicant respectfully requests the rejections under 35 U.S.C. § 103(a) be withdrawn.

Double Patenting

The Examiner provisionally rejected claims 13-25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8-11 and 13-15 of co-pending Application No. 10/552,908. Applicant traverses this rejection for the following reasons.

The subject matter of the present invention is directed to naphthalene derivatives in which the hydroxyl group at the β or 2-position is alkylated while the subject matter of the claims in co-pending Application No. 10/552,908 is directed to naphthalene derivatives which contain a hydroxyl group at the β or 2-position. Based on the arguments set forth above, Applicant respectfully submits the subject matter of the claims of the present invention is patentably distinct from that claimed in co-pending Application No. 10/552,908. Accordingly, Applicant requests the provisional rejection of the claims 13-25 under the judicially created doctrine of obviousness-type double patenting be withdrawn.

Conclusion

It is respectfully submitted that claims 13-25 are patentable and are in a condition for allowance. Applicant respectfully requests all pending claims be allowed and that the application pass to issuance.

Should any fee be due in connection with the filing of this document, the Commissioner for Patents is hereby authorized to deduct said fee from Huntsman Corporation Deposit Account No. 08-3442.

Respectfully Submitted,

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